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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/489,739 01/21/00 D ZMURA

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EXAMINER

WM01/0228

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POINTVILLE
ART UNIT PAPER NUMBER

2164
DATE MAILED:

02/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/489,739

Applicant(s)
D'Zmura

Examiner
Frantzy P Invil

Group Art Unit
2164



☒ Responsive to communication(s) filed on Dec 13, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-4 is/are pending in the applicat

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. Claims 5-12 are canceled from the Response to the Restriction Election dated 12/13/00.
2. An examination of this application reveals that applicant is unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

3. It is called to applicant's attention that if a communication is mailed before the response time has expired applicant may submit the response with a "Certificate of Mailing" which merely asserts that the response is being mailed on a given date. So mailed, before the period for response has lapsed, the response is considered timely. A suggested format for a certificate follows:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Assistant Commissioner for Patents
Washington, D.C. 20231
on _____ (date).

Typed or printed name of person signing this certificate

Signature _____

Date _____

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4. This application is informal in the arrangement of the specification. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of Specification

The following order or arrangement is preferred in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated below. Other headings should be avoided.

- (a) Title of the Invention.
- (b) Cross-References to Related Applications (if any).
- © Statement as to rights to inventions made under Federally-sponsored research and development (if any).
- (d) Background of the Invention:
 - 1. Field of the Invention
 - 2. Description of the Prior Art.
- (e) Summary of the Invention.
- (f) Brief Description of the Drawing.
- (g) Description of the Preferred Embodiment(s).
- (h) Claim(s).
- (I) Abstract of the Disclosure.

Applicant is advised as to how to arrange the content of the specification.

- (a) **Title of the Invention.** The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive, preferably from two to seven words.
- (b) **Cross-References to Related Applications:** (if any).
- © **Statement as to Rights to inventions made under Federally sponsored research and development:** (if any).
- (d) **Background of the Invention:** The specification should set forth the Background of the Invention in two parts:
 - (1) **Field of the Invention:** A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S.

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patent classification definitions or the subject matter of the claimed invention. This item may also be titled "Technical Field."

- (2) **Description of the Prior Art:** A description of the prior art known to the applicant and including, if applicable, references to specific prior art problems which are solved by the applicant's invention. This item may also be titled "Background Art."
- (e) **Summary:** A brief summary or general statement of the invention is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases, it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (f) **Brief Description of the Drawing(s):** A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (g) **Description of the Preferred Embodiment(s):** A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. This item may also be titled "Best Mode for Carrying Out the Invention." Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (h) **Claim(s):** (See 37 CFR 1.75) A claim may be typed with the various elements subdivided in paragraph form. There may be plural indentations to further segregate subcombinations or related steps. The claim(s) must be in one sentence form only.

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(I) Abstract of the Disclosure.

5. If applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed.

6. The abstract of the disclosure is objected to because it contains words such as "invention". Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

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Extensive mechanical and design details of apparatus should not be given.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The spacing of the lines of the specification is such as to make reading and entry of amendments difficult. New application papers with lines double spaced on good quality paper are required.

Since applicant must amend his specification to incorporate double spacing if he continues to prosecute the application, and should amendments be wished to be entered for corrections, applicant is advised a substitute specification is required. The substitute specification filed must be accompanied by a statement that it contains no new matter. Such statement must be a verified statement if made by a person not registered to practice before the Office.

8. The drawings are objected to for reasons as set forth by the Office Draftsman on form PTO-948, and are also objected to under 37 C.F.R. § 1.83(a). Applicants are reminded that each and every claim element must be found in the drawings as required by 37 CFR 1.83(a) and also the drawings and specification must describe, show and correspond for all components shown or

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discussed as required by 37 CFR 1.84(p). The drawings must show every feature of the invention specified in the claims. Therefore, all means and elements claimed must be shown by supported in the figures or the features canceled from the claims. This means where structure is claimed, be it in method or apparatus type claims, such structure must be clear as to its intended meaning and correspondence with the elements in the drawings. All method steps are considered "elements" or "features" of claims and also must find support in the figures. Software or programs per se cannot be relied upon as support for means or structure claimed, because such are not structure as these type limitations require. The various claimed "means" are not seen supported by specific structure. If support exists in the drawings and written specification, this support should be pointed out so that it is clear on the record what applicants intend these various means-plus-function to cover and the basis in the written specification for what their alternative equivalents are.

Correction is required without adding new matter. Any changes to the drawings which require changes to the written disclosure so that they correspond, or vice-versa, should be made along with complying with the Draftsman's requirements.

Applicants are reminded that when submitting a proposed drawing correction any proposal by applicants for amendment of the drawings to cure defects must consist of two parts:

- a) A *separate* letter to the Draftsman in accordance with MPEP § 608.02(r); and
- b) A print or pen-and-ink sketch showing changes in *red ink* in accordance with MPEP § 608.02(v).

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The filing of new formal drawings to correct the noted defect may be deferred until the application is allowed by the examiner. However, the proposed drawing correction request must be submitted in response to this office action. Failure to comply may result in a response being held non-responsive or the application being held abandoned.

9. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Specification

10. The specification is objected to under 37 CFR 1.96 because:

Applicants' notations of text and charts are not permitted in the appendices as submitted. Only computer program listings and embedded textual annotations are permitted in specification appendices. Applicant is suggested to include such in the specification pursuant to 37 CFR 1.52.

It is noted that the specification are replete with charts/graphics. Applicant is reminded that graphics and images are not text and must therefore be included with the figure sheets. Any diagrams containing graphical components must be submitted as figures and normal drawing sheets.

Applicant has submitted a bibliography noted as page 54 in the filed specification. It is unsure whether applicant desires the references in the Bibliography page to be considered by the Examiner since a copy of each of these references was not provided and also since no IDS

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containing these references was filed. If applicant desires these references to be considered by the Examiner, then applicant is advised to submit a copy of each of those references accompany by an IDS and a PTO 1449-Form referring to these references.

Also, it is unclear whether other entities/parties have contributed to the claimed invention or portion of the specification. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. *Claim 1-4 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.*

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to

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present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

Applicant merely describes various desired results of their claimed invention. The claimed parts and the various formulas render the claims vague and indefinite since they are not explicitly set forth and defined in applicant's written disclosure and drawings.

The Examiner suggests that if a method claim(s) is/are to be recited, a series of discrete steps defining the intended result set forth in the preamble should be positively recited. If an apparatus claim is to be recited, enough structure for enabling the claimed invention should be recited. Furthermore, the examiner cannot determine where the inventive concept lies, and cannot apply art rejections.

As per claims 2-4, line 1 of each of claims 2-4, the phrase "In the invention" renders the claims vague and indefinite because it is not in proper format. See MPEP section 608.01(n).

Also, on line 1 of each of claims 2-4, "the invention" lacks clear antecedent basis.

12. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph

35 USC, first paragraph requires that the specification shall contain a written description of the invention and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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The specification merely discloses concepts for analytic valuation of financial instruments and estimation of pricing sensitivity, interest-bearing assets and liabilities using various formulas. The specification fails to concentrate on distinct aspects of the claimed invention. The specification also provides material(s) other than permissible material(s) having no bearing on the claimed invention. Applicant is advised to remove them, particularly the "Notes", "Bibliography", "Exhibits" sections. The functions are so broadly claimed and disclosed as to be directed to any and all computers to carry out the claimed functions.

Before a patent can be issued, it is required that the disclosure sets forth an invention in such a clear and concise terms as to enable a person skilled in the art to make and use the invention, not a statement what may or may not happen with the desired invention. Clearly, it would require the skilled artisan an inordinate amount of experimentation to achieve the invention. Since applicant does not disclose such information, the applicant has failed to provide the required enabling disclosure.

Claim Rejections - 35 USC § 101

13. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, specifically, as directed to an abstract idea.

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Claims 1-4 represent an abstract idea that does not provide a practical application in the technological arts. See *State Street vs. Signature*, 38 USPQ2d 1530. The claims do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus encompass any product of the class configured in any manner to perform the underlying process. Thus, in the claims, no physical transformation is performed, and no practical application is found for estimating changes in prices of securities. The claims also do not appear to correspond to a specific machine or manufacture disclosed within the instant specification and thus encompass any product of the class configured in any manner to perform the underlying process. Consequently, the claims are analyzed based upon the underlying process, and are thus rejected as being directed to a non-statutory process. Thus, the claimed invention with the language of the preamble is a statement of intended use that does not limit the claim to a practical application in the technological art and are rejected under 35 USC 101.

14. The claims are replete with deficiencies as noted above. Proper determination of art issues cannot be ascertained. No further consideration with pertinent prior art is warranted at this time (See *In re Steele et al.*, 134 USPQ 292 and *Ex parte Brummer*, 12 USPQ 2d, page 1654.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wolfberg et al. (5,214,579) discloses a goal-oriented investment system for indexing, tracking and monitoring the growth of an investment and the amount of time for a cumulative investment to reach a target amount.

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Finbrock et al. (5,592, 379) discloses a method and system for pooling and distributing bond dividends.

Atkins (4,953,085) discloses a system for analyzing an investment.

16.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil, whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday through Thursday from 7:30 AM to 6:00 PM.

The fax phone number for this Art Unit is (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

FP

26Feb01


Frantzy Poinvil
Primary Examiner
Art Unit 2164